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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER KE, PENG	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/848,231

Applicant(s)

APPELMAN, BARRY

Examiner

SIMON KE

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/C2.06)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to communications: Amendment, filed on 3/31/11.

Claims 1-56 are pending in this application. Claims 1, 18, 22, and 26 are independent claims. In the Amendment, filed on 6/30/04, claims 1, 18, 22, and 26 were amended.

Drawings

The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

As per claims 1-56, the drawing fails to show “wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and
determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient.”

As per claim 5, the drawing fails to show “e-mail message comprises an invitation to join the communications system.”

As per claim 7, the drawing fails to show “the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message.”

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-56 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification fails describe “wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and determining the online state

of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient.”

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification fails describe “e-mail message comprises an invitation to join the communications system.”

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification fails describe “the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message.”

Claims 1-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specification fails describe “wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient.”

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specification fails describe “e-mail message comprises an invitation to join the communications system.”

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specification fails describe “the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message.”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 4, 6 - 9, 11 - 68, and 71-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 200210021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 further in view of Schindler (US 6,081,830) further in view of Mattaway US Patent 7,149,208.

As per claim 1, Glenn et al. ("Glenn") teaches a communications method for transferring electronic data between users of a communications system, the method comprising: upon opening of the electronic message by the recipient, indicating an online state of one or more of the sender and any other recipient of the electronic message (see Glenn, paragraphs 0021 and 0022).

Glenn does not teach delivering an e-mail from a sender to at least one recipient and the electronic message as an e-mail message.

Kudoh et al. ("Kudoh") teaches delivering an e-mail message from a sender to at least one recipient and the electronic message as an e-mail message (see Kudoh, column 4, lines 32 - 36). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Kudoh with the method of Glenn in order to allow messages to be read hours or days after they are sent.

Glen and Kudoh teach the method of claim 1. (see rejection above). Glenn and Kudoh do not teach the method indicating one other recipient of the electronic message.

Schindler further teaches a method indicating the online state of the sender and every other recipient of the chat room. (See Schindler, column 7, lines 45-55)

It would have been obvious to an artisan at the time of the invention to include Schindler's teaching with method of Glenn and Kudoh in order to allow user to see the states of the other users.

However, they fail to teach wherein indicating the online state comprises: determining an identity of one or more of the sender or any one other recipient by stripping a domain

name from an email address associated with the one or more of the sender or any one other recipient, and

determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient,"

Mattaway teaches determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and

determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient" (see Mattaway, col. 24, lines 1-40)

It would have been obvious to an artisan at the time of the invention to include Mattaway's teaching with method of Glenn and Kudoh in order to allow user to ability to check user online statue with email-address.

As per claim 2, which is dependent on claim 1, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 further comprising sending a message to at least one of the sender and any other recipient based on the online state (see Glenn, paragraph 0046).

As per claim 3, which is dependent on claim 2, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 2 (see rejection above). Glenn further teaches the method of claim 2 wherein the message comprises an instant message (see Glenn, paragraph 0046).

As per claim 4, which is dependent on claim 2, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 2 (see rejection above). Glenn further teaches the method of claim 2 wherein the message comprises an e-mail message (see Glenn, paragraph 0046).

As per claim 6, which is dependent on claim 1, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 wherein indicating the online state comprises displaying a graphical user interface to the recipient (see Glenn, figure 3, items 206 and 209 and paragraph 0022).

As per claim 8, which is dependent on claim 1, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above), Glenn further teaches wherein indicating the online state comprises indicating whether the sender is online, offline, or not a member of the communications system (see Glenn, paragraph 0022).

As per claim 9, which is dependent on claim 1, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 wherein indicating the online state comprises accepting a request to check user online state (see Glenn, paragraph 0045, lines 10 -15; it is inherent that the query to check user online state is accepted because a result is returned).

As per claim 11, which is dependent on claim 9, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 9 (see rejection above). Glenn further teaches the method of claim 9 wherein the request comprises an Internet protocol (see Glenn, paragraph 0025; the examiner interprets the AOL instant messaging protocol as an internet protocol),

As per claim 12, which is dependent on claim 11, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 11 (see rejection above). Glenn discloses the method of claim 11 wherein the Internet protocol is hypertext transfer protocol (see Glenn, paragraph 0011).

As per claim 13, which is dependent on claim 9, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 9 (see rejection above). Glenn further teaches the method of claim 9 wherein the request is initiated by a client of the user (see Glenn, paragraph 0045, lines 10 - 15).

As per claim 14, which is dependent on claim 9, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 9 (see rejection above). Glenn further teaches the method of claim 9 further comprising sending a redirection command based on the online state (see Glenn, paragraph 0046; the examiner interprets sending the message via electronic mail instead of as an instantaneous message when the user is offline as sending a redirection command based on the online state).

As per claim 15, which is dependent on claim 9, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 9 (see rejection above). Glenn further teaches the method of claim 14 wherein the redirection command comprises a uniform resource locator (see Glenn, paragraph 0056, lines 17 - 24).

As per claim 16, which is dependent on claim 1, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches wherein, indicating the online state comprises establishing a persistent connection to an instant messaging server (see Glenn, paragraph 0068).

As per claim 17, which is dependent on claim 1, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches wherein indicating the online state comprises checking a control port (see Glenn, paragraph 0127).

As per claim 18, it is of similar scope to claim 1 and is rejected under the same rationale as claim 1 (see rejection above).

As per claim 19, which is dependent on claim 18, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a disc (see Glenn, paragraph 0150, lines 5 - 8).

As per claim 20, which is dependent on claim 18, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a client device (see Glenn, paragraph 0017).

As per claim 21, which is dependent on claim 18, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a host device (see Glenn, paragraph 0153, lines 3 - 6).

As per claim 22, which is dependent on claim 18, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a propagated signal (see Glenn, paragraph 0152).

As per claim 23, it is of similar scope to claim 1 and is, rejected under the same rationale as claim 1 (see rejection above).

As per claim 24, it is of similar scope to claim 20 and is rejected under the same rationale as claim 20 (see rejection above).

As per claim 25, it is of similar scope to claim 21 and is rejected under the same rationale as claim 21 (see rejection above).

As per claim 26, it is of similar scope to claim 1 and is rejected under the same rationale as claim 1 (see rejection above).

As per claim 27, it is of similar scope to claim 6 and is rejected under the same rationale as claim 6 (see rejection above).

As per claim 28, which is dependent on claim 18, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 27 wherein a graphical user interface enabled for a first online state differs from a graphical user interface enabled for a second online state (see Glenn, paragraph 0022).

As per claim 29, it is of similar scope to claim 6 and is rejected under the same rationale as claim 6 (see rejection above).

As per claim 30, it is of similar scope to claim 28 and is rejected under the same rationale as claim 28 (see rejection above).

As per claim 31, which is dependent on claim 1, it is of the same scope as claim 8. (See rejection above)

As per claim 32, which is dependent on claim 1, it is of the same scope as claim 2. (See rejection above)

As per claim 33, which is dependent on claim 1, it is of the same scope as claim 2. (See rejection above)

As per claim 34, which is dependent on claim 1, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1. (see rejection above). Schindler further teaches a method indicating the online state of the sender and every other recipient of the chat room. (See Schindler, column 7, lines 45-55)

As per claim 35, which is dependent on claim 1, it is of the same scope as claim 8. (See rejection above)

As per claim 36, which is dependent on claim 1, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 1, Glenn further teaches where indicating online state comprises providing one or more indicator to the recipient. (Figure 2, item 206)

As per claim 37, which is dependent on claim 36, it is of the same scope as claim 34. (See rejection above)

As per claim 38, which is dependent on claim 36, it is of the same scope as claim 34. (See rejection above)

As per claim 39, which is dependent on claim 36, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 36, Glenn further teaches comprising selecting at least one of the visual indicators to initiate at least one user interface. (Figure 2, item 206)

As per claim 40, which is dependent on claim 39, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 39, Kudoh further teaches wherein selecting the at least one visual indicator initiates at least one user interface configured to enable the recipient to send an email message communication to an identity associated with visual indicator. (see Kudoh, column 4, lines 32 - 36)

As per claim 41, which is dependent on claim 39, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 39, Glenn further teaches wherein selecting the at least one visual indicator initiates at least one user interface configured to enable the recipient to send an instant message communication to an identity associated with the visual indicator. (See Glenn, paragraph 0046)

As per claim 42, which is dependent on claim 18, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 18, Glenn further teaches wherein the instruction for indicating the online state comprise instruction for indicating the online state of the sender of the e-mail message. (See Glenn, paragraph 0046)

As per claims 43-45 are rejected with the same rationale as claim 34. (See rejection above)

As per claim 46, which is dependent on claim 18, it is of the same scope as claim 39. (See rejection above)

As per claim 47, which is dependent on claim 23, it is of the same scope as claim 42. (See rejection above)

As per claims 48-50 are rejected with the same rationale as claim 34. (See rejection above)

As per claim 51, which is dependent on claim 23, it is of the same scope as claim 8. (See rejection above)

As per claim 52, which is dependent on claim 26, it is of the same scope as claim 42. (See rejection above)

As per claims 53-55 are rejected with the same rationale as claim 34. (See rejection above)

As per claim 56, which is dependent on claim 26, it is of the same scope as claim 8. (See rejection above)

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 200210021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 further in view of Schindler (US 6,081,830) further in view of Mattaway US Patent 7,149,208 and further in view of Danieli US Publication 2010/0184517.

As per claim 5, which is dependent on claim 4, Glenn, Kudoh and Schindler teach the method of claim 4 (see rejection above). They do not teach the method of claim 4 wherein the e-mail message comprises an invitation to join the communications system. Danieli teaches wherein an e-mail message comprises an invitation to join the communications system (see Danieli, paragraph 0065). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Danieli with the method of Glenn, Kudoh and Schindler in order to allow the user to provide other users with access to private discussion information.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 200210021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 further in view of Schindler (US 6,081,830) further in view of Mattaway US Patent 7,149,208 and further in view of Bate US Patent 7,076,546.

As per claim 7, which is dependent on claim 6, Glenn, Kudoh, Schindler, and Mattaway teach the method of claim 6 (see rejection above). However, they fails to teach the method of claim 6 wherein the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message.

Bate teaches the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message. (see Bate, fig. 12, col. 15, lines 30-55)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Bate with the method of Glenn, Kudoh and Schindler in order to allow the user with an easier way to identify other user's online statue.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 200210021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 as applied to claim 9 above, further in view of Schindler (US 6,081,830), and further in view of Bunney, U.S. Patent No. 6,446,112.

As per claim 10, which is dependent on claim 9, Glenn, Kudoh, Schindler teach the method of claim 9 (see rejection above). They do not teach the method of claim 9 wherein the request comprises at least one e-mail address. Bunney et al. ("Bunney") teaches wherein a request to check user online state comprises at least one e-mail address (see Bunney, column 10, lines 1 - 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Bunney with the method of Glenn, Kudoh, and Schindler in order to allow a user to link existing email addresses with internet chat handles.

Response to Argument

Applicant's arguments with respect to claims 1-56 have been considered but are deemed to be moot in view of the new grounds of rejection.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIMON KE whose telephone number is (571)272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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